

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

OCT 22 1998

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY MAGLICA

Appeal No. 97-3131
Application No. 07/411,576¹

HEARD: September 16, 1998

RE MAILED

DEC 01 1998

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before McCANDLISH, Senior Administrative Patent Judge, STAAB and NASE, Administrative Patent Judges.

McCANDLISH, Administrative Patent Judge.

ORDER TO SHOW CAUSE

AND

REMAND TO EXAMINER

¹ Application for patent filed September 22, 1989. According to appellant, this application is a continuation of application 07/356,361 filed May 3, 1989, currently pending; which is a continuation of application 07/222,378 filed July 19, 1988, now U.S. Patent 4,899,265 issued February 6, 1990; which is a continuation of application 07/034,918 filed April 6, 1987, now abandoned; which is a continuation of application 06/828,729 filed February 11, 1986, now U.S. Patent 4,658,336 issued April 14, 1987; which is a continuation of application 06/648,032 filed September 6, 1984, now U.S. Patent 4,577,263 issued March 18, 1986.

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The order to show cause here concerns the new grounds, which the examiner added in paragraphs a and b on page 2 of his advisory office action mailed November 12, 1996 (Paper No. 38) and which he reiterated on page 4 of his answer mailed February 21, 1997 (Paper No. 40), in support of his rejection under 35 U.S.C. § 112, first paragraph, and also in support of his refusal to grant appellant the benefit of the filing date of his first filed utility application (see footnote 1 supra) under 35 U.S.C. § 120. These additional grounds appear to have been prompted by the examiner's entry of appellant's third amendment after final filed on September 5, 1996 and substituting a new sheet of drawings (containing Figures 1-4) for the previously pending sheet of drawings.²

Under 37 CFR § 1.196(d) (amended effective December 1, 1997)³ appellant is ordered to show cause why the appeal in this application should not be dismissed because of appellant's failure to address the additional grounds set

² With regard to the exhibits attached to appellant's brief, appellant's statement on page 3 of his brief that Exhibit I contains the pending drawings is incorrect. Because of the entry of appellant's third amendment after final, Exhibit II contains the pending drawings.

³ As amended, 37 CFR § 1.196(d) provides in pertinent part that "[t]he Board of Patent Appeals and Interferences may require an appellant to address any matter that is deemed appropriate for a reasoned decision on the pending appeal."

forth in paragraphs a and b on page 2 of the examiner's advisory office action mailed November 12, 1996 and reiterated on page 4 of the examiner's answer. It should be noted that each of these additional grounds by itself may be the basis for supporting the § 112, first paragraph, rejection and also for denying appellant the benefit of the filing date of his first filed utility application under 35 U.S.C. § 120.⁴

On remand, the examiner is ordered to consider the adequacy of appellant's response, if any, to our order to show cause and to take whatever action he deems to be appropriate. In the event that a response to our order to show cause is timely filed by appellant and in the event that the examiner considers that response to be sufficient to avoid a dismissal of this appeal but is insufficient to overcome the standing rejections, the examiner is further ordered to file a supplemental answer specifically identifying the drawings referred to on page 4 of the answer as the "original formal" drawings (or simply the "original" drawings) and, also, the drawings referred to on page 4 of answer as the "original mechanical drawings." The examiner

⁴ With regard to the matter concerning the absence of the parting line in the flashlight head shown in the pending drawings, the examiner's attention is directed to pages 20-22 in our second decision (Paper No. 49) in appellant's companion application 07/410,965.

is also required to attach to the supplemental answer photocopies of the original formal drawings and the original mechanical drawings. A clear identification of these drawings is of paramount importance for resolving the issues raised by the examiner's rejection under the first paragraph of § 112 and by the examiner's refusal to grant appellant the benefit of the filing date of his first filed utility application.

It appears that the "original mechanical drawings" mentioned in the examiner's answer are the original utility application drawings filed in appellant's first filed utility application. However, the record before us does not clearly reflect which drawings were originally filed in this application along with the original specification. In this regard, there is evidence in the record to indicate that the single sheet of drawings attached hereto as exhibit I is a photocopy of the drawings as originally filed in the instant application. This appears to be confirmed by the fact that each photocopy of this single sheet of drawings in the file bears the official stamped notation (located at the top of the sheet) that the photocopy is a print of the drawings as originally filed.

The drawings in exhibit I obviously are not the original utility application drawings. Instead, the single

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sheet in exhibit I contains only four views similar to the pending drawings, namely the perspective, side elevation, top plan and bottom plan views of the flashlight.

As further evidence that the sheet of drawings in exhibit I is a photocopy or print of the drawings as originally filed in the instant application, the file contains a further copy of this sheet of drawings bearing the original mail room date stamp on the backside of the sheet. However, there is conflicting evidence in the file. In particular, the file also contains two additional sheets of drawings which also bear the original mail room date stamp on their backsides. These two additional sheets are photocopies of the drawings originally filed in appellant's first filed utility application. With the general exception of the perspective view, the Figures in these two sheets of utility application drawings obviously do not correspond to the Figures in the sheet of drawings in exhibit I.

There is also further evidence that these two sheets of utility application drawings are the originally filed drawings in the instant application. In this regard, the instant application was filed as a "streamlined" continuation of the utility application 07/356,361 under 37 CFR § 1.60 which was in effect at the time the instant application was filed. According to the Rule 60 application

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papers, two sheets, not one sheet, of drawings were filed along with 14 pages of specification which evidently came from the utility application, thus suggesting that the two sheets of utility application drawings were the originally filed drawings.

Of additional interest is the preliminary amendment which was filed concurrently with the Rule 60 application. According to this preliminary amendment, two sheets of informal drawings were originally filed in the instant application, thus further suggesting that the two sheets of utility application drawings were originally filed in the instant application, not the single sheet of drawings in exhibit I. As stated on page 2 of this preliminary amendment, "three sheets of drawings" submitted with the preliminary amendment were substituted for the two sheets of originally filed drawings. It is possible that the three sheets of drawings mentioned in the preliminary amendment were simply three photocopies of the single sheet of drawings in exhibit I.

Needless to say, a proper identification of the original drawings filed in the instant application is of paramount importance. In addition to having a bearing on the rejection under the first paragraph of § 112, this matter also has a bearing on whether the instant application

should have been accorded a filing date in the first instance. As evidenced by the text on page 2 of appellant's Rule 60 application papers, the provisions of Rule 60, which were in effect at the time the instant application was filed, provided that the signing of the continuation application by the applicant may be omitted if the copy of the application is a true copy of the prior application as filed. If the sheet of drawings in exhibit I is a photocopy of the drawings as originally filed in the instant application, then a question is raised as to whether the instant Rule 60 application should have accorded a filing date because, under such circumstances, the copy of the application would not have been a true copy of the prior utility application.

On remand, therefore, the examiner is required to make a finding setting forth which drawings were originally filed in the instant application and to take whatever action is appropriate depending upon that finding.

The period for responding to the foregoing order under 37 CFR § 1.196(d) is set to expire ONE month from the mailing date of this letter remanding this application to the examiner.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting

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FIG. 1.

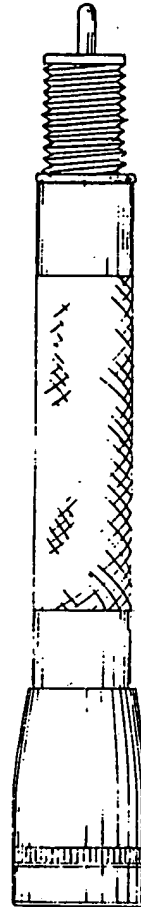


FIG. 2.



FIG. 3.

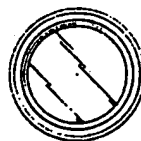


FIG. 4.